

that new claims 24-26 were restricted out into a unelected group X. The applicants reserve their right to assert these claims in a duly filed divisional application.

Claim 1 was rejected under 35 U.S.C. §112, first paragraph for reasons of record in Paper No. 7. The basis of this rejection was that the phrase "one or more N in a ring" was considered to read on a ring that can potentially contain 5 nitrogen atoms.

Reconsideration is requested.

When terms that are used in a patent claim are construed, they are to be read as being directed to operable materials and components. In the present case, the term "one or more" was used to point out certain heterocyclic nitrogen structures that can be used to achieve the results set forth in the specification. The Courts have held that patent claims are to be given their broadest "reasonable" interpretation that is consistent with the specification. Raytheon Co. v. Roper Corp., 220 USPQ 592, 597 (Fed. Cir. 1983). This means that it is improper for the Examiner to postulate structures that may exist, but would not be considered by one who is skilled in the art as being within the scope of the disclosed invention. The claims do not have to be limited to the preferred embodiments as such a limitation would not serve the purpose of promoting progress in the useful arts. In re Goffe, 191 USPQ 429, 431 (CCPA 1976). The Examiner is invited to review MPEP§2164.08 for additional authority as to the required scope of enablement in a patent claim.

The specification is directed to one who is skilled in the art and as such it does not have to recite that which is well known in the art. One who is skilled in this art can readily prepare the various compounds of claim 1 without the exercise of inventive faculty. The Examiner has not pointed to any particular compound which cannot be made based on the present specification and the skill of the art.

Attached hereto is a copy of U.S. 6,303,622 which has been granted to the present applicants. The scope of the claims in that granted patent are not materially deferent from the

claims of the present application with regard to the substituents that are present on the benzo[c]quinolizine derivatives. The granted patent should be considered in connection with the determination of scope and the definiteness of the claims of the present application. The definitions of R<sup>1</sup>, R<sub>2</sub>, R<sub>3</sub>, R<sub>4</sub> and R<sub>6</sub> in the granted patent are similar to the definitions of R<sup>1</sup>, R<sub>2</sub>, R<sub>3</sub>, R<sub>4</sub> and R<sub>6</sub> in the present application and are not unduly broad considering the level of skill in the art of pharmaceutical chemistry.

It is not necessary for an applicant for a patent to have tested each species within the scope of a generic claim. It is only necessary that the disclosure be sufficient to enable one of ordinary skill in the art to practice the invention without undue experimentation. A patent should not be so restricted in scope that it provides a blueprint for making embodiments that would enable an infringer to avoid the patent and thus render the patent incapable of protecting the true scope of an invention. For these reasons, it is requested that this ground of rejection be withdrawn.

Claims 1-2 and 11-12 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter that the applicant regards as the invention.

Reconsideration is requested.

The propriety of the use of the term "saturated or unsaturated aromatic heterocycle containing one or more N atoms" has been discussed supra and it is not believed necessary to repeat the arguments that have been presented with regard to this term. The term "or more" does not appear in new claim 28 and it is requested that that claim be favorably considered.

Claims 11 and 12 have been canceled and are no longer at issue.

It is assumed that Claim 3 is allowable except that it is dependent on a rejected claim. Since it is believed that claim 1 is now in allowable form, it is not necessary to amend claim 3.

In paragraph 4 of the Office Action, claims 1 and 10-12

were rejected under 35 U.S.C. §102(b) as being anticipated by CA 103:195974.


Reconsideration is requested.

The CA 103:195974 reference is an Abstract of J. Chem. Research (S) 1985, 169, a copy of which is attached to this Amendment. This reference only discloses quinolizines where the unsaturated heterocycle group is unsubstituted. The claimed compounds all are substituted on the unsaturated ring as shown in claim 1. In addition, there is no X substituent as claimed by the applicant in the compounds of the cited reference. This argument was previously presented and the Examiner has not acknowledged that the cited reference is concerned with a different ring system. Clarification is requested.

New claim 27 is based on canceled claim 11 and it points out the use as a process as required by 35 U.S.C. §100.

An early and favorable action is earnestly solicited.

Respectfully submitted,

  
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